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09/785,094

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Gregory D. Gudorf

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10/19/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|---|--|
| Office Action Summary | Application No. 09/785,094 | Applicant(s) GUDORF, GREGORY D. | |
| | Examiner Hussein A. El-chanti | Art Unit 2157 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to amendment received on July 24, 2006. Claims 52-55 were newly added. Claims 1-15 and 17-55 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 52-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure of the application does not describe "the plurality of audio files are exclusively accessible to different authentication information and the central location is configured to permit concurrent submission of the identification information of the user and audio file identification, without first transmitting a song selection list of the device".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-10, 12-15 and 17-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Zoest et al., U.S. Patent No. 6,609,105 (referred to hereafter as Van).

Van teaches the invention explicitly as claimed including a system and method for downloading songs over the internet in response to performing user authentication (see abstract).

As to claim 1, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device (see col. 1 lines 33-50, user uploads songs to a website),

(b) associating the audio files with identification information (see col. 1 lines 33-50, the songs are personalized and protected by a user password),

(c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information (see col. 1 lines 33-50, songs are stored on the website),

(d) receiving at said central location said identification information from a second device (see col. 1 lines 33-50, user can access the songs from any web accessible terminal),

(e) transmitting said audio files to said second device upon receipt of said identification information (see col. 1 lines 33-50, songs are downloaded to client in response to client request).

As to claim 2, Van teaches the method of claim 1 wherein said server is a web server and said files and information are received and transmitted via the Internet (see col. 1 lines 33-50).

As to claim 3, Van teaches the method of claim 1 wherein at least one of said devices is a general purpose computer (see col. 1 lines 33-50).

As to claim 4, Van teaches the method of claim 3 wherein at least one of said devices is a personal computer (see col. 3 lines 55-63).

As to claim 6, Van teaches the method of claim 1 wherein at least one of said devices is a personal digital assistant (see col. 3 lines 53-65).

As to claim 7, Van teaches the method of claim 6 wherein said personal digital assistant receives said audio files via wireless communication (see col. 3 lines 53-65).

As to claim 8, Van teaches the method of claim 1 further comprising encoding said electronic files from a source of audio information (see col. 1 lines 55-col. 2 lines 7).

As to claim 9, Van teaches the method of claim 8 wherein said source is a compact disk (see col. 1 lines 55-col. 2 lines 7).

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As to claim 10, Van teaches the method claim 1 wherein said electronic files are compatible with the MPEG format when received at said central location (see col. 1 lines 33-40).

As to claim 12, Van teaches the method of claim 1 further comprising receiving said identification from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 13, Van teaches the method of claim 1 wherein said step of receiving at said central location said identification information comprises said second device automatically sending said identification information to said central location (see col. 1 lines 25-col. 2 lines 7).

As to claim 14, Van teaches the method of claim 12 or 13 wherein said identification information is associated with said device. (see col. 1 lines 25-col. 2 lines 7).

As to claim 15, Van teaches the method of claim 14 wherein said first device and said second device are the same device (see col. 1 lines 25-col. 2 lines 7).

As to claim 16, Van teaches the method of claim 1 wherein said identification information is associated with a user (see col. 1 lines 25-col. 2 lines 7).

As to claim 17, Van teaches the method of claim 16 wherein said step of associating said audio files with identification information comprises a user sending information which identifies the user (see col. 1 lines 25-col. 2 lines 7).

As to claim 18, Van teaches the method of claim 1 wherein said identification information is sent from said first device when said first device is connected to said central location via a network (see col. 1 lines 25-col. 2 lines 7).

As to claim 19, Van teaches the method of claim 18 wherein said network is the Internet (see col. 1 lines 25-col. 2 lines 7).

As to claim 20, Van teaches the method of claim 19 wherein said identification information is sent automatically by said first and second devices to said central location (see col. 1 lines 25-col. 2 lines 7).

As to claim 21, Van teaches the method of claim 1 further comprising the step of receiving at said central location a request for at least one of said files and wherein said step of transmitting comprises transmitting said at least one of said files (see col. 1 lines 25-col. 2 lines 7).

As to claim 22, Van teaches the method of claim 21 further comprising the step of comparing the identification information associated with said requested file with the identification information received during said step of receiving said identification information from said second device, and said step of transmitting is conditional upon the results of said comparison (see col. 1 lines 25-col. 2 lines 7).

As to claim 23, Van teaches the method of claim 22 further comprising the step of transmitting to said second device a list of the files associated with the identification information received from said second device (see col. 1 lines 25-col. 2 lines 7).

As to claims 24 and 25, Van teaches the method of claim 23 wherein the user is limited to a predetermined amount of space on the central location (see col. 1 lines 23-37).

As to claim 26, Van teaches the method of claim 1 wherein said second device is at a geographic location remote from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 27, Van teaches the method of claim 1 wherein said step of transmitting comprises downloading said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 28, Van teaches the method of claim 27 wherein said step of transmitting comprises streaming said file to said second device (see col. 1 lines 25-col. 2 lines 7).

As to claim 29, Van teaches the method of claim 27 wherein said step of transmitting comprises permitting said second device to permanently store said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 30, Van teaches the method of claim 1 further comprising:

(a) receiving at said central location electronic files representing audio signals from a third device, said third device having different identification information,

(b) storing the audio files from said third device on a portion of said storage media that is different from the portion uniquely associated with said identification information associated with said audio files from said first device (see col. 1 lines 25-col. 2 lines 7).

As to claim 31, Van teaches a system for storing and transmitting audio information comprising:

a processor;

memory;

data stored in said memory, said data identifying a plurality of users or devices, said data further comprising a plurality of files associated with audio information, each said file being uniquely associated with the identity of a single user or device;

a set of instructions executable by said processor, said instructions conditioning the transmission of a song from the system to a user or device based on the identity of the user or device associated with said audio information (see col. 1 lines 25-col. 2 lines 7).

As to claim 32, Van teaches the system of claim 31 wherein the total size of files stored in said data for a particular user or device is limited (see col. 1 lines 25-col. 2 lines 7).

As to claim 33, Van teaches the system of claim 32 wherein a file associated with a first user is identical to a file associated with a second user and said data comprises two copies of said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 34, Van teaches the system of claim 31 wherein said system comprises a server (see col. 1 lines 25-col. 2 lines 7).

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As to claim 35, Van teaches the system of claim 34 further comprising an audio player connected via a network to said server, said audio player being identified by at least some of the data identifying a plurality of users or devices (see col. 1 lines 25-col. 2 lines 7).

As to claim 36, Van teaches the system of claim 35 wherein said audio player comprises memory containing information identifying said player (see col. 1 lines 25-col. 2 lines 7).

As to claim 37, Van teaches the system of claim 36 wherein said audio player further comprises a speaker and a processor for playing said file (see col. 1 lines 25-col. 2 lines 7).

As to claim 38, Van teaches the system of claim 36 wherein said audio player sends the identification information automatically to said server (see col. 1 lines 25-col. 2 lines 7).

As to claim 39, Van teaches the system of claim 36 wherein said remote device is a PDA (see col. 1 lines 25-col. 2 lines 7).

As to claim 41, Van teaches the system of claim 31 wherein said identification information comprises a portable audio player (see col. 1 lines 25-col. 2 lines 7).

As to claims 42 and 51, Van teaches a method of storing and transmitting songs comprising:

uniquely associating a portion of the storage space on a server with a user or device;

associating said portion with a first identifier;

receiving said first identifier;

receiving a song file representative of a song; and

storing said song file in the portion of said storage space associated with said first identifier;

receiving a second identifier and a request for said song file;

comparing said second identifier with the identifier associated said requested song file;

transmitting said song file in response to said request depending upon the outcome of said step of comparing (see col. 1 lines 25-col. 2 lines 7).

As to claim 43, Van teaches the method of claim 42 wherein if a first file is received along with a first identifier and a second file is received along with a second identifier and said first file and second file are identical copies of one another, then said first file is stored on a portion of said storage space different from the portion where said second file is stored (see col. 1 lines 25-col. 2 lines 7).

As to claim 44, Van teaches the method of claim 43 further comprising the step of tracking the number of times a song file has been transmitted (see col. 1 lines 25-col. 2 lines 7).

As to claim 45, Van teaches the method of claim 42 wherein said step of storing said song file in the portion of said storage space associated with said first identifier occurs prior to said step of associating said portion with a first identifier (see col. 1 lines 25-col. 2 lines 7).

As to claim 46, Van teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from said user (see col. 1 lines 25-col. 2 lines 7).

As to claim 47, Van teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from a bank of song files (see col. 1 lines 25-col. 2 lines 7).

As to claim 48, Van teaches the method of claim 47 further comprising the step of said song bank preventing access to said song file stored at said song bank for an amount of time (see col. 1 lines 25-col. 2 lines 7).

As to claim 49, Van teaches the method of claim 48 wherein said amount of time is determined by the number of times a user is permitted to download the song (see fig. 3).

As to claim 40 and 50, Van teaches the identification information comprises a GUID (see col. 2 and 4 lines 49-56).

As to claim 52, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device (see col. 1 lines 33-50, user uploads songs to a website),

(b) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information (see col. 1 lines 33-50, songs are stored on the website),

(c) receiving at said central location said identification information from a second device (see col. 1 lines 33-50, user can access the songs from any web accessible terminal),

(d) transmitting said audio files to said second device upon receipt of said identification information (see col. 1 lines 33-50, songs are downloaded to client in response to client request);

wherein different stored sets of files of the plurality of audio files on the central system are exclusively accessible to different authentication identification information,

wherein the central location is configured to permit concurrent submission of the authentication identification of the user and the file for transmitting at least one of the audio files to the device, without first transmitting a song selection list of the device (see col. 18 lines 55-col. 19 lines 50).

As to claims 53-55, Van teaches the method and system of claims 1, 31 and 42 respectively wherein the central location is configured to permit concurrent submission of the authentication identification of the user and the file by the second device (see col. 18 lines 55-col. 19 lines 50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van.

As to claim 5, Van teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device, (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information, (d) receiving at said central location said identification information from a second device, (e) transmitting said audio files to said second device upon receipt of said identification information (see the rejection of claim 1) where the second device can be a portable computer, laptop, PDA etc.. where the files are downloaded using wireless communication.

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Van does not explicitly teach the limitation "second device is installed in an automobile". Official Notice is taken that one of the ordinary skill in the art at the time of the invention would modify Van to implement the second device in an automobile because doing so would allow the user to download and listen to songs from the internet and therefore overcome the need of using a physical storage device such as CD ROM or diskette and therefore having easier and more efficient method of saving audio files.

As to claim 11, Van does not explicitly teach the limitation electronic files are compatible with the ATRAC3 format when received at said central location". Van teaches the audio files can be saved in MPEG, .au, .snd, .aiff, etc. file formats. Official Notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Van by incorporating ATRAC3 format because doing so would allow the user to download audio files in different formats and using different software to play the audio file and therefore overcoming the limitation of a specific software to play the audio file.

Affidavit

7.61 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient

Evidence of Conception

5. The supplemental affidavit or declaration Under 37 CFR 1.131 filed on March 20, 2006 has been considered but is ineffective to overcome the Van reference.

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6. The evidence submitted on Oct. 24, 2005 is insufficient to establish a conception of the invention prior to the effective date of the Van reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Exhibit A shows a general idea of uploading songs to a server and accessing the songs from a different device. The supplemental declaration states on page 2 that "your music server" concept was to be used with some form of user authentication such as a user name and password that would associate the user to particular audio files or a personal account. The authentication with a user name and password concept that would associate a user to particular audio files based on the user "log in" information is not "clearly" shown in Exhibit A and therefore the submitted evidence does not show conception for the claim limitations (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information and (d) receiving at said central location said identification information from a second device.

7. The evidence submitted on July 24, 2006 is insufficient to establish a conception of the invention prior to the effective date of the Van reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea

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of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Applicant relies on a discussion between Mr. Gudorf and Mr. Beckwitt to show conception for the claim language. A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. Therefore applicant's statement is insufficient to show conception.

8. Accordingly, applicant has not established prior invention. The rejection is maintained.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Oct. 10, 2006


ABDULHAMID SALAD
PRIMARY EXAMINER